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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,505	07/12/1999	STEPHEN PHILIP JACKSON	MEWE-005	5221

7590

05/31/2002

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EXAMINER

ROBINSON, HOPE A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 05/31/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/341,505

Applicant(s)

Jackson et al.

Examiner

Hope Robinson

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Feb 13, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Apr 1, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s):

See the attached sheet.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 6, 19, 22, and 25

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Art Unit: 1653

DETAILED ACTION

1. Applicant's response to the Final Office Action mailed September 21, 2001 in Paper No. 19 on February 13, 2002 is acknowledged. It is noted that applicant filed a Declaration by Stephen P. Jackson.

2. Applicant's arguments filed February 13, 2002 have been fully considered but have were not persuasive.

The rejection under 35 U.S.C. 112, first paragraph is maintained.

The rejection under 35 U.S.C. 112, second paragraph is withdrawn.

Claim Disposition

3. Claim 5 and 7 has been canceled. Claims 1-3, 6, 19, 22 and 25 have been amended. Claims 1-4 and 6-28 are pending. Claims 1-4, 6, 19, 22 and 25 are under examination.

4. The following grounds of rejection are or remain applicable :

Claim Rejections - 35 U.S.C. § 112

Art Unit: 1653

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The rejection of record under 35 U.S.C. 112, first paragraph remains over claims 1-4, 6, 19, 22 and 25 because the amendments made were not sufficient to overcome this ground of rejection. The claims are directed to an assay method for a compound which inhibits the binding between XRCC4 and DNA ligase IV etc., (see for example claim 1) comprising bringing into contact XRCC4, a test compound and one or more components such as DNA ligase IV. The claims do not specify what the compound is that is being used to inhibit XRCC4 or how to find such a compound and as pointed out in the prior office action specification does not disclose the function of the protein. It is noted that applicant submitted a Declaration which has been considered, however, was not convincing. Page 2 of the Declaration states that XRCC4 binds to DNA ligase IV in cells and that they play an important role in non-homologous end joining (NHEJ). However, the "important" role is not disclosed. It is also stated that DNA ligase IV plays a role in NHEJ which is mediated by the binding of XRCC4, again what the exact role played is, is not disclosed. As stated in the office action the mere binding of XRCC4 to DNA ligase is not a specific function. Thus, as the Declaration and the remarks made on pages 3-6 of the amendment submitted are just mere argument, thus, is not persuasive. It is suggested that

Art Unit: 1653

applicant amend the claims to recite “ a method for identifying a compound X that inhibits the binding of XRCC4 and DNA ligase IV, or, the method comprising the step of:

(i) contacting XRCC4 with compound X and DNA ligase IV or DNA-PK..., under conditions wherein the said compound inhibits the binding between XRCC4 and DNA ligase IV or”

6. Applicant is reminded that the non-elected claims need to be canceled

Conclusion

7. Claims 1-4, 6, 19, 22 and 25 are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday-Friday from 9.00 am to 5.30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, Ph.D., can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Art Unit: 1653

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope Robinson, MS ~~MS~~

Patent Examiner

Karen Cochrane Carlson PhD

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER